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Paper No. 14
JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Innovative Marble & Tile Inc.**

Serial No. 75/460,970

Myron Amer for applicant.

Stacey Johnson, Trademark Examining Attorney, Law Office
113 (Meryl Hershkowitz, Managing Attorney).

Before Quinn, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by **Quinn**, Administrative Trademark Judge:

An application has been filed by Innovative Marble & Tile, Inc. to register the mark IMT ITALIA ("ITALIA" disclaimed) for "providing product information services for others in the name of [sic] printed materials concerning the source of ceramic and porcelain tile, marble, granite, limestone and agglomerates."¹

¹ Application Serial No. 75/460,970, filed April 2, 1998, alleging first use anywhere and first use in interstate commerce on January 5, 1998.

The Trademark Examining Attorney has refused registration on the ground that the specimens do not show use of the applied-for mark in connection with the services recited in the application.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs.² An oral hearing was not requested.

Applicant, in its brief, begins its arguments by stating that the recitation of services is "not totally accurate of applicant's services or more satisfactory to the applicant than the recitation of services as filed with the application."³ Applicant goes on to state that it has "expertise in the characteristics of 'ceramic and porcelain tile, and marble, granite, limestone and agglomerates' and using this expertise counsels clients on the appropriate use of these materials, and also is knowledgeable

² Attached to applicant's brief is a glossy folder captioned "Innovative Marble & Tile Press Release, New Products, Information...And More", inside of which are the referenced materials. The Examining Attorney, in her brief, objected to the evidence as untimely, and also pointed out that, in any event, none of the materials showed use of the mark sought to be registered. The objection is well taken and the materials do not form part of the appeal record. Trademark Rule 2.142(d). Even if considered, this evidence is of no value to the issue herein given that the materials do not show any use of the involved mark.

³ The original recitation of services read "providing information to third parties of sources of ceramic and porcelain tile, and marble, granite, limestone and agglomerates."

concerning the foreign sources from which it is advisable to purchase these materials, it being a marketplace fact that these materials are best imported, than purchased domestically." Although the remainder of applicant's arguments are not entirely clear to us, applicant contends, as best we understand it, that it provides information to others about the goods listed in the recitation of services, and that the materials submitted during prosecution are acceptable specimens showing use of the mark in connection with such services.

The Examining Attorney maintains that the various specimens submitted by applicant do not show use of the mark in connection with the specific services recited in the application. The Examining Attorney also argues: "The Examining Attorney does not dispute the fact that applicant may be providing information to its customers while in the showroom. What is unclear from the specimens is whether the applicant is rendering information services, which by definition, must include the provision of information for the benefit of others rather than information which is merely information about the goods sold and is not a service." (brief, pp. 5-6)

Whether a specimen is acceptable to evidence use of the subject matter as a service mark depends upon whether

it shows use of the mark in association with the recited services (i.e., in their sale or advertising). The manner of use on the specimens must be such that potential purchasers would readily perceive the subject matter as identifying and distinguishing applicant's services and indicating their source. Section 45 of the Trademark Act, Trademark Rule 2.58 and *Trademark Manual of Examining Procedure*, §1301.04.

The original specimens of record consist of an invoice and an accompanying cover letter. We acknowledge that invoices may be acceptable service mark specimens provided that they show the mark and refer to the relevant services, and that letterhead stationery bearing the mark may be accepted if the services are clearly indicated thereon. The problem with these specimens is that, while the mark appears thereon, there is no reference or any indication to the services for which applicant seeks registration, namely "providing product information services for others in the name of printed materials concerning the source of ceramic and porcelain tile, marble, granite, limestone and agglomerates." Rather, the specimens show use of IMT ITALIA in connection with the sale of tile by applicant.

The substitute specimens submitted by applicant are in the nature of an advertisement it placed in

ClipperMagazine. The advertisement is for applicant's "warehouse showroom" which, the advertisement indicates, is "now open the public...now buy below retail and save." Although this advertisement indicates "buy direct from importer" and shows the mark used in connection with applicant's sale of imported marble, porcelain granite and ceramic, there is no reference whatsoever to the services of providing information for others about these products.

The other material submitted by applicant consists of a product brochure captioned "RETRO 2000." Again, although applicant insists that it has expertise in flooring materials and that it provides information to purchasers to aid them in selecting products from third parties, these services are not referenced in what seems to be an ordinary product brochure bearing applicant's trade name and applied-for mark. To the extent that the brochure contains information about marble products, it is nothing more than a brochure about products sold by applicant (see the back of the brochure indicating "a product of IMT ITALIA"), as opposed to any third party.

In sum, the materials are devoid of any indication that applicant is a provider of information about sources, other than itself, of tile, marble, etc. Thus, to the extent that applicant is providing a service separate and

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apart from the sale of its own imported products, there are no specimens showing use of the mark in connection with such services. None of the materials convinces us that purchasers encountering them would make an association between applicant's mark and the recited services; rather, the association more likely would be between the mark and the sale of ceramic and porcelain tile, marble, granite, limestone and agglomerates for applicant's own benefit.

Cf: In re Ralph Mantia Inc., 54 USPQ2d 1284 (TTAB 2000).

Decision: The refusal to register is affirmed.

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